

Appl. No. 10/024,766
Amdt. Dated January 20, 2005
Reply to Office Action of November 8, 2004

REMARKS

Claims 1 through 18 remain pending in this Application.
Claims 1, 9, and 14 have each been currently amended.

5 "Claims 1-3, 5, 6, and 8-13 are rejected under 35 U.S.C.
102(b) as being clearly anticipated by Wynn U.S. Patent No.
5,859,419." As will be discussed in greater detail below,
Applicant has amended the claims to insure that they clearly
are not anticipated or made obvious by the teachings of Wynn
10 whether taken individually, or in combination with the other
cited reference, Lofgren 6,608,911.

As indicated by Applicant, for example in the "Summary of
the Invention," Applicant provides a programmable information
tag for amongst other elements that can be programmed to
15 provide an e-receipt to a consumer for completing a commercial
transaction between the consumer and a merchant providing
goods or services utilizing e-commerce. The tag is programmed
to serve as a receipt for showing that the consumer paid for
goods or services from a merchant, with the transaction being
20 completed by the consumer using the tag receipt for obtaining
delivery of goods or services. Also, as indicated on page 7
of the specification, lines 18 through 21, the tag permits the
consumer or the individual purchaser to provide a secure e-
receipt to a merchant or service provider before completion of
25 the transaction. The merchant or service provider uses a tag
reader to read information from the tag into a personal
computer to confirm the consumer has been pre-qualified to
receive the goods or services such as a rental car, hotel

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room, merchandise, attendance at an entertainment event, and so forth.

Claim 1, has been currently amended to call for apparatus for permitting the aforesaid use of the tag for providing a
5 secure electronic receipt for completing a transaction. Claim 1 (currently amended) now calls for the following:

An apparatus comprising:
a transportable programmable information tag
uniquely encoded for association with an individual
10 purchaser of goods and/or services;
a communication unit capable of communicating information to one or more information interfaces;
a controller, coupled to the programmable
information tag and the communication unit, arranged to
15 receive information from the information interfaces through the communication unit, and program the programmable information tag with at least part of the information from the information interface;
a tag reader for reading said tag to obtain
20 information therefrom;
wherein the programmed information relates to goods or services to be provided by a merchant or service provider to the individual purchaser uniquely associated with said programmable information tag, whereby said
25 individual purchaser thereafter uses the programmed information tag to obtain delivery of the goods or services.

Wynn actually teaches away from the present invention of
30 Claim 1 (currently amended). Wynn does not even allude to the use of a "transportable programmable information tag" in combination with other apparatus as now claimed. Wynn has no teaching associated with an e-receipt or electronic receipt for use by a consumer to verify purchase or ordering of goods
35 and/or services. The teachings of Wynn are focused on using a universal financial data card for storing financial transaction records pertaining to a plurality of financial accounts, as indicated in the Abstract. Also, in column 4, lines 17 through 60, this teaching is confirmed. Wynn's

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application of a UFDC (universal financial data card) is different than the programmable information tag of Applicant. For example, in column 4, on lines 57 through 62, it is indicated that "In accordance with one particularly
5 advantageous aspect of the present invention, multiple accounts having different types, e.g., checking accounts, savings accounts, credit card accounts, securities accounts, may all be stored in the same UFDC 201." No teaching was found in Wynn for using the UFDC for providing a secure means
10 of permitting a consumer to complete a transaction and receive delivery of goods and/or services from a merchant or service provider. Lofgren adds nothing to the teachings of Wynn that would make the combination of elements of Claim 1 (currently amended) obvious. Accordingly, Claim 1, as currently amended,
15 is patentable over the cited references.

Claims 2, 3, 5, 6, and 8 are each dependent from Claim 1 (currently amended). Accordingly, these claims are patentable for at least the same reasons as Claim 1 (currently amended).

Claim 9, as currently amended, is now claiming the
20 following:

An e-commerce method, comprising the steps of:
receiving a request to complete a commercial
transaction for goods or services over the Internet by a
consumer;
25 completing the commercial transaction with the
consumer;
providing an e-receipt to the consumer, the e-
receipt containing information that may be used by the
consumer to program an RFID tag to prove a transaction
30 for obtaining the delivery of goods or services;
using the programmed RFID tag to permit the
consumer to receive the goods or services; and
recording information related to the commercial
transaction and the e-receipt.
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From the above-given comments regarding the teachings of Wynn, it is clear that Wynn does not anticipate or make obvious the combination of steps of Claim 9. More specifically, it is clear that Wynn does not anticipate or
5 make obvious the step of ". . . providing an e-receipt to the consumer, the e-receipt containing information that may be used by the consumer to program an RFID tag to prove a transaction for the delivery of goods or services;" nor the
10 step of "using the programmed RFID tag to permit the consumer to receive the goods or services." Accordingly Claim 9, as currently amended, is patentable over Wynn whether taken individually, or in combination with Lofgren.

Claims 10 through 13 are each ultimately dependent from Claim 9 (currently amended). Accordingly, these claims are
15 patentable for at least the same reasons as Claim 9 (currently amended).

"Claims 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynn, U.S. Patent No. 5,859,419 in view of Lofgren et al., U.S. Patent No. 6,608,911." Claim 4 is
20 dependent from Claim 1 (currently amended), and as such is patentable for at least the same reasons as the latter.

"Claims 7 and 14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wynn, U.S. Patent No. 5,859,419." Claim 7 is ultimately depended from Claim 1 (currently
25 amended), and as such is patentable for at least the same reasons as the combination of Claim 1 (currently amended) and Claim 2.

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Claim 14, as currently amended, is claiming the following:

A system for performing e-commerce transactions, comprising:
5 means for receiving a request to complete a commercial transaction for goods or services over the Internet by a consumer;
means for completing the commercial transaction with the consumer;
10 means for providing an e-receipt to the consumer, the e-receipt containing information that may be used by the consumer to program an RFID tag to prove a transaction for the right to receive the goods or services;
15 means for using the programmed RFID tag to permit the consumer to receive the goods or services; and
means for recording information related to the commercial transaction and the e-receipt.

20 From comments previously made above in distinguishing Claim 1 (currently amended), and Claim 9 (currently amended) from Wynn, it is clear that the system of Claim 14 (currently amended) is patentable over Wynn.

Applicant would like to bring to the attention of the
25 Examiner the following cases which emphasize that one should not read a claimed invention into prior art references through use of hindsight, when such references are void of teaching the invention as claimed.

It is stated in In re Sernaker, 217 U.S.P.Q. 1, 6
30 (C.A.F.C. 1983): "prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

It is clear that the suggestion to combine
35 references should not come from Applicant, as was

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forcefully stated in Orthopedic Equipment Co. v United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983): "It is wrong to use the patent in suit [here the application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

Also, the case law is clear in guarding against the use of hindsight in reading Applicants invention into the prior art, which art is clearly not disclosing the Applicants invention as claimed. Applicants would like to bring the following cases to the Examiner's attention:

The Supreme Court in Calmar, Inc. v. Cook Chemical Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966), in which the Court warns the dangers of "slipping into hindsight", citing the case of Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406, 141 U.S.P.Q. 549 (6th Cir., 1964), where the doctrine is stated:

We now come to the patented device which after all is the subject matter

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of this case. At the outset we take
note of two well-established
principles. The first is that in
considering the questions of
5 obviousness, we must view the prior art
from the point in time prior to when
the patented device was made. Many
things may seem obvious after they have
been made and for this reason courts
10 should guard against slipping into use
of hindsight. We must be careful to
"view the prior art without reading
into that art the teachings of
appellant's invention." Application of
15 Sporck, 301 F.2d 686, 689 (C.C.P.A).

The courts have long held that there must be some
teaching in the references cited to suggest the
combination of the references in a manner to obtain the
combination of elements of the rejected claim(s). It is
20 well known that in order for any prior art references
themselves to be validly combined for use in a prior-art
§ 103 rejection, the references themselves, or some other
prior art, must suggest that they be combined.

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As was stated in Uniroyal, Inc. v Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), "where prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

Applicant believes that he has shown that the claims as now presented are in condition for allowance. Accordingly, it is respectfully requested that the claims be allowed and the case passed to issue.

Respectfully submitted,



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